

REMARKS

In response to the Official Action dated 4/8/2003, the above-identified application has been amended. Review and reconsideration are requested in view of the above amendments and following remarks.

The Examiner required restriction requirement of claims 13-18 and the same have been canceled at this time without prejudice as being non-elected claims.

The Examiner objected to the disclosure because of the following informalities: Line 22, Page 5 states "optic fiber 18". The optic fiber has previously been referred to with reference numeral 28. On Page 7 in the 4th paragraph through the first full paragraph on Page 5, the microendoscope is referred to with reference numeral 26; the microendoscope has previously been referred to with reference numeral 23.

The specification has been amended. Withdrawal of the objection is requested.

The Examiner objected to the claim 1 because of the following informalities: line 3 begins with "includes". Appropriate correction is required.

Claim 1 has been amended. Withdrawal of the objection is requested.

Claims 5-8 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It was stated that Claim 5 recites the limitation "said housing" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 has been amended to remove the antecedent basis. Withdrawal of the rejection is

requested.

Claims 1-5 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent Application No. 2002/0165467 to Rutenberg. It is stated that:

In reference to claims 1-5, and 9-12, Remijan et al. discloses applicant's claimed invention including an introducer needle [0043], a microendoscope having an optic fiber (26) [0038] which is operable insertable into the needle [0047] in a manner to enable an image to be obtained therethrough. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchinson, 69 USPQ 138. In the present case the needle disclosed by Remijan et al. is capable of insertion into a female such that the terminal end of the needle is adjacent to the ovary. Remijan et al. discloses a stylet (80) extending through the needle to block material from entering the needle [4005]. The optic fiber disclosed by Remijan et al. extends out of an open connector surface (36) of a housing and has a length equal to the needle [0038][0041][0049]. The angled connection between the housing and the light source in figure one is considered by the examiner to be a v-shape. The microendoscope disclosed by Remijan et al. has a fiber optic light source (40) operably connected to the housing [0039] so that the fiber is illuminated. Remijan et al. discloses a flexible protective tubing (34) [0038] covering the optic fiber. Remijan discloses performing a procedure through the operative channel of the endoscope [0085] and discloses that such a procedure could be removing a gynecological tissue sample [0009], but fails to disclose a tissue removing member operable co-insertable into the needle for removal of tissue cells. Rutenberg teaches a cytological brush that passes through the operative channel in an endoscope to remove surface epithelial cells. Rutenberg teaches that the size of the brush and the structure of the brush can be varied [004]. It would have been obvious to one having ordinary skill in the art to modify the microendoscope as disclosed by Remijan et al. to include a cytological brush as taught by Rutenberg in order to perform non-lacerational biopsies of the ovary.

Clearly, the amendments to the claims define over Remijan alone or in combination with Rutenberg. Neither discloses, teaches or suggests the claimed combination. Neither teaches, discloses or suggests a structure as now claimed which can perform the invention. Withdrawal of the rejection is kindly requested.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2003/0083552 to Remijan et al. in view of Rutenberg. It was stated:

Rutenberg discloses a camera (30) being connected to a monitor (46) operably connected to a computer (44) having software to enable viewing of the image [0040]. However, Remijan et al. fails to disclose the monitor being a touch screen monitor, and the computer including a microphone and having voice recognition software associated with the microphone to permit notes to be recorded. Adair teaches an endoscopic video touch screen monitor (Col. 4 lines 36 - 42; lines 49 - 65) and a computer having a microphone and voice recognition software associated with the microphone to permit notes to be recorded (Col. 4, lines 58 - 65; Col. 8, lines 60 - 62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the monitor and computer as disclosed by Remijan et al. in view of Rutenberg to be a touch screen monitor and to include a microphone and voice recognition software associated with the microphone in order to remove the need for a keyboard and allow the surgeon to control the endoscope and record data hands free.

For the reasons stated above, neither Remijan alone or in combination with Rutenberg disclose, teach or suggests the claimed combination. Withdrawal of the rejections of claims 6-8 is kindly requested.

Accordingly, withdrawal of the rejections is respectfully requested and allowance of claims 1-12 is requested at as early a date as possible. This is intended to be complete response to the Official Action dated 6/6/2003. A petition for extension of time of one month is attached hereto with PTO form 2038.

Respectfully submitted,



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I hereby certify that this correspondence is being faxed to the PTO fax number 703-308-0758 for group 3736 on the date shown below.

Date, October 6, 2003



R. William Graham